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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
10/672,431	09/26/2003	John M. Burns	HSJ9-2003-140-US1	8425	
23980 75	590 04/18/2006		EXAM	EXAMINER	
REED INTELLECTUAL PROPERTY LAW GROUP			RENNER,	RENNER, CRAIG A	
1400 PAGE MILL ROAD PALO ALTO, CA 94304-1124 ART UN		ART UNIT	PAPER NUMBER		
,			2627 DATE MAILED: 04/18/2006		

Please find below and/or attached an Office communication concerning this application or proceeding.

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	Application No.	Applicant(s)	
	10/672,431	BURNS ET AL.	
Office Action Summary	Examiner	Art Unit	
	Craig A. Renner	2627	
The MAILING DATE of this communication app Period for Reply	pears on the cover sheet with the c	correspondence address	·-
A SHORTENED STATUTORY PERIOD FOR REPLY WHICHEVER IS LONGER, FROM THE MAILING D/ Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication. If NO period for reply is specified above, the maximum statutory period v Failure to reply within the set or extended period for reply will, by statute Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION 36(a). In no event, however, may a reply be tir vill apply and will expire SIX (6) MONTHS from , cause the application to become ABANDONE	N. nely filed the mailing date of this communi D (35 U.S.C. § 133).	
Status			
1) Responsive to communication(s) filed on			
2a) ☐ This action is FINAL . 2b) ☑ This	action is non-final.		
3) Since this application is in condition for allowar	-		its is
closed in accordance with the practice under E	Ex parte Quayle, 1935 C.D. 11, 4	53 O.G. 213.	
Disposition of Claims			
 4) Claim(s) 1-31 is/are pending in the application. 4a) Of the above claim(s) is/are withdraw 5) Claim(s) is/are allowed. 6) Claim(s) is/are rejected. 7) Claim(s) is/are objected to. 8) Claim(s) 1-31 are subject to restriction and/or example. 	vn from consideration.		
Application Papers			
9) The specification is objected to by the Examine 10) The drawing(s) filed on is/are: a) accomplicant may not request that any objection to the Replacement drawing sheet(s) including the correct 11) The oath or declaration is objected to by the Examine	epted or b) objected to by the drawing(s) be held in abeyance. Section is required if the drawing(s) is ob	e 37 CFR 1.85(a). jected to. See 37 CFR 1.1	` '
Priority under 35 U.S.C. § 119			
 12) Acknowledgment is made of a claim for foreign a) All b) Some * c) None of: 1. Certified copies of the priority documents 2. Certified copies of the priority documents 3. Copies of the certified copies of the priority application from the International Bureau * See the attached detailed Office action for a list 	s have been received. s have been received in Applicati rity documents have been receive u (PCT Rule 17.2(a)).	ion No ed in this National Stago	e
Attachment(s) 1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date	4) Interview Summary Paper No(s)/Mail Da 5) Notice of Informal P 6) Other:		

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1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-17, drawn to a "disk drive system" with a "charge-control additive", classified in class 360, subclass 323.
- II. Claims 18-24, drawn to a "disk drive system" with a "replacement lubricant", classified in class 360, subclass 97.01.
- III. Claims 25-31, drawn to a "disk drive system" with a "lubricant" having a "DC relative electrical permittivity no greater than about 25,000", classified in class 360, subclass 99.08.
- 2. The inventions are distinct, each from the other because of the following reasons: Inventions of groups I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, the subcombination of group I has separate utility such as usable in a disk drive system not including a "replacement lubricant having a lower relative electrical permittivity", for instance. See MPEP § 806.05(d).

Inventions of groups I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, the subcombination of group I has separate utility such as usable in a disk drive system including a lubricant with a DC

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relative electrical permittivity "greater than about 25,000 at 50°C", for instance. See MPEP § 806.05(d).

Inventions of groups II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, the subcombination of group II has separate utility such as usable in a disk drive system including a lubricant with a DC relative electrical permittivity "greater than about 25,000 at 50°C", for instance. See MPEP § 806.05(d).

- 3. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification and/or because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
- 4. A telephone call was made to Louis L. Wu on 13 April 2006 to request an oral election to the above restriction requirement, but did not result in an election being made.
- 5. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the

requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

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Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

- 6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).
- 7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Craig A. Renner whose telephone number is (571) 272-7580. The examiner can normally be reached on Tuesday-Friday 9:00 AM - 7:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa T. Nguyen can be reached on (571) 272-7579. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Craig A. Renner
Primary Examiner
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